REMARKS

Summary

Claims 1-3 were pending and all of the claims were rejected in the Office Action. New Claims 4-10 have been added to further claim subject matter to which the Applicant is entitled. No new matter has been added. The Applicant has carefully considered the references and the reasons for rejection advanced by the Examiner and respectfully traverses the rejections on the basis that a *prima facie* case of obviousness has not been made out.

Claim Rejections

35 U.S.C §103 (a)

Claims 1-3 were rejected under 35 U.S.C. §103 (a) as being unpatentable over Jackson (US 4,931,782; "Jackson") in view of Donohue et al. (US 6,262,717; "Donohue") The Applicants respectfully traverse the rejection on the basis that a *prima facie* case of obviousness has not been made out.

The Examiner asserts that Jackson may be modified by Donohue in order to make out a *prima facie* case of obviousness.

Jackson teaches that electrodes in sensor laminates are fragile and are subject to breakage if the electrodes contained therein are placed in a state of tension. (Id., col. 8 lines 2-35 and Figs. 4 and 5). Jackson further teaches that a transparent laminate may be constructed to avoid this problem, and the laminate disposed on the face of a CRT [12]. (Id. col. 8, lines 43-44) so that when the surface opposite to that contacting the CRT [12] is pressed by a stylus [24], the conductors [34,36] are not placed in tension. However, in order for the device to operate, the stylus [24] must deform the substrate. A very thin cover sheet [60], about 1 mil thick, may be applied to a surface of the laminate opposite to that of the CRT [12] to provide scratch resistance and durability. (Id, col 9, lines 11-22).

The Examiner accepts that the cover sheet [60] is not disclosed as an insulating support plate to support the sensor. One can deduce from the above discussion that the CRT face provides the insulating support plate.

The Examiner states that Donohue discloses a kiosk with a touch pad input system where the touch pad is positioned beneath a cover plate [31](Donohue, Figs. 1 and 2, element 31) and that the touch pad can be bonded or adhered to the touch surface of the touch pad (Id, col 7, lines 38-39). (Office action, page 2). To be clear, Donohue states that "[t]he cover plate 31, although it is most preferably formed of glass for durability and cosmetics, may also be formed of a polymer ...or adhered to the touch sensitive surface 26....". (Donohoue, col 7, lines 35-40). The cover plate of Dohohue is intended to be a rigid member. (Id., col 5, lines 29-31). The Examiner asserts that the cover plate [31] of Donohue can be placed on top of the touch pad of Jackson, and that the seating arrangement of Donohue (Fig. 2, element 47) would not be enough to assure that the touch pad stayed in contact with the cover sheet and, therefore the cover sheet would also provide support to the touch pad. The thicknesses of cover sheets taught by Donohue are in the range of thickness range 0.01 inches to 0.07 inches (equivalent to 10 to 70 mils). (Id., col 7, lines 47-49)

Not only does Jackson teach away from the combination as suggested by the Examiner, but the resultant combination would be unsuitable for its intended purpose. The intended purpose of Jackson is to provide a coordinate input device suitable for applying to the faceplate of a CRT. So, if the Examiner's reasoning would be adopted, the coordinate input laminate would be sandwiched between a rigid surface as taught by Donohue and the CRT glass as taught by Jackson. The stylus would cause no deformation of the input laminate, and the sensor would be inoperative. The Federal Circuit has held that "a proposed modification [is] inappropriate for an obviousness inquiry when the modification render[s] the prior art reference inoperable for its intended purpose. *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)." *In re Fritch*, 972 F.2d 1260, 1265-1266 n.12, 23 USPQ2d 1780, 1783 n.12 (Fed. Cir.1992).

Even if the rigid surface of Donohue is applied to the outer surface of the coordinate input device and there is no CRT surface behind the laminate, the rigid nature of the surface taught by Dohohue (as indicated above, the thickness taught by Donohue is at least 10 times the thickness taught by Jackson) would distribute the pressure applied by the stylus over a wide area, making the sensor poorly adapted to

determining the position of the stylus, since the stylus of Jackson appears to be sensing some signal associated with the deformation of the input laminate.

In another aspect, even if the rigid surface of Donohue is applied to the outer surface of the coordinate input device and there is no CRT surface behind the laminate, the resultant device would be unsatisfactory for its intended purpose. *Arguendo*, a laminate is applied to a back side of the rigid surface of Donohue, and there is no rigid surface behind the laminate. If the rigid surface of Donohue were to deflect under the pressure of the stylus as argued by the Examiner, Jackson teaches that such deflection would put the ITO traces in the laminate in tension. This is precisely the situation that Jackson teaches is to be avoided.

For at least these reasons, the primary reference, Jackson, cannot be modified by the secondary reference, Donohue, as argued by the Examiner.

To summarize, there are at least three reasons that a *prima facie* case of obviousness has not been made out: (1) a rigid plate placed over the sensor, where the sensor is applied to a CRT or equivalent, would prevent deflection of the sensor; (2) the thickness of the surface taught by Donohue is sufficiently greater than that taught by Jackson that there is no showing that the pressure applied by the stylus would be effective; and, (3) if the CRT was not present at the back surface of the sensor taught by Jackson, the traces would be placed in tension by the depression of the stylus and would break, as taught by Jackson.

Whether any of such combinations would teach all of the elements and limitations of the present Claim 1 is moot, as the combinations are either inoperative or unsatisfactory for its intended purpose, for any of the reasons given above.

Further, the motivation cited by the Examiner for combining the references is redundant, as Jackson already provides the surface 60 for protection of the device from scratches. (Jackson, col. 9, lines 11-21) Thus, any motivation to combine the references must arise from the teachings of the present Applicant, and such a combination is impermissible hindsight. *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983) ("To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record

convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.")

For at least the reasons given above, Claim 1 is not obvious and is allowable. Claims 2 and 3, being claims dependent on an allowable claim are allowable, without more.

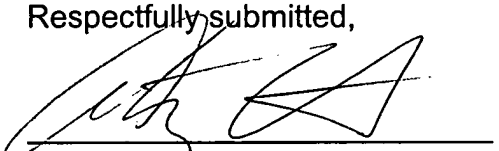
Conclusion

Claims 1- 10 are pending.

For at least the reasons given above, the Applicant respectfully submits that the pending claims are allowable.

The Examiner is respectfully requested to contact the undersigned in the event that a telephone interview would expedite consideration of the application.

Respectfully submitted,



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